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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,840	06/15/2001	Setsuji Tatsumi	Q64945	6600
2292	7590	03/24/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BRINICH, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT      PAPER

20060316

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner for Patents

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/880,840	TATSUMI, SETSUJI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen M. Brinich	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 February 2006.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 4-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 13 is/are withdrawn from consideration.
- 5) Claim(s) 14 is/are allowed.
- 6) Claim(s) 4-7 and 12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 8-11 & 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/9/06.
2. Applicant's election with traverse of claims 4-7 & 12 in the reply filed on 2/9/06 is acknowledged. The traversal is on the ground(s) that no serious burden is presented to Examiner by examining all claims. This is not found persuasive because examination of the nonelected claims directed to the scanning of a film image requires a field of search (e.g. class 348, at least some of subclasses 96 through 112) that is not required for examination of the elected claims.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 4-5, 7 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaughnessy et al.

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Re claims 4 & 12, Shaughnessy et al (Figure 1a) discloses a reflective (mirror 94) scanner for reading a print image having hand-applied (column 6, lines 14-22) identifying marks indicating the position of image elements. The image is corrected on the basis of these identifying marks.

In the case of identifying marks indicating the location of an element to be removed from the image (column 6, lines 56-58), the element to be removed is readable upon the recited "defect" (i.e. they are elements recognized by the user as undesired, and their presence in the final output would be a fault in the produced image).

Re claims 5 & 7, Shaughnessy et al (column 8, lines 56-59) discloses the use of a comparison operation upon the scanned image data (to a threshold level readable upon the (not further specified) "print image" data) to define the image correction operations to be performed.

Re claim 4, Shaughnessy et al does not specify the correction of a defect of the specific listed types (e.g. a scratch, a dust mark, a stain, etc).

The use of the "erase" mark (column 6, lines 56-58) in the case in which an operator notes a stain upon the document and wishes to remove (and thus correct) it would read upon this recitation.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art for a user of the Shaughnessy device to make an "erase" mark on a document stain.

The suggestion/motivation for doing so would have been to produce an unstained copy of the document.

Therefore, it would have been obvious to use the "erase" mark of Shaughnessy on a document with a detected stain to obtain the invention as specified in claims 4-5, 7 & 12.

5. Claims 4-5, 7 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al.

Re claims 4 & 12, Ng et al (Figure 1a) discloses a reflective (mirror 94) scanner for reading a print image having hand-applied (column 5, lines 26-35) identifying marks indicating the position of image elements. The image is corrected on the basis of these identifying marks.

In the case of identifying marks indicating the location of an element to be removed from the image (column 5, line 67 - column 6, line 2), the element to be removed is readable upon the recited "defect" (i.e. they are elements recognized by the user as undesired, and their presence in the final output would be a fault in the produced image).

Re claims 5 & 7, Ng et al (column 7, lines 19-22) discloses the use of a comparison operation upon the scanned image data

(to a threshold level readable upon the (not further specified) "print image" data) to define the image correction operations to be performed.

Re claim 4, Ng et al does not specify the correction of a defect of the specific listed types (e.g. a scratch, a dust mark, a stain, etc).

The use of the "erase" mark (column 5, line 97 - column 6, line 2) in the case in which an operator notes a stain upon the document and wishes to remove (and thus correct) it would read upon this recitation.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art for a user of the Ng device to make an "erase" mark on a document stain.

The suggestion/motivation for doing so would have been to produce an unstained copy of the document.

Therefore, it would have been obvious to use the "erase" mark of Ng on a document with a detected stain to obtain the invention as specified in claims 4-5, 7 & 12.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaughnessy et al in view of Hibino et al.

Re claim 6, Shaughnessy et al discloses (column 14, lines 3-7) the display of the scanned image on a display device.

Shaughnessy et al does not describe the display of the scanned image in an enlarged state. The enlargement of a scanned image for display on a monitor is well known in the art as disclosed for example by Hibino et al (column 3, lines 58-67). The use of such enlargement of the scanned image of Shaughnessy et al to generate such an enlarged image would be an expedient obvious to one of ordinary skill in the art. The motivation for the use of such enlargement would be to provide a more detailed monitor image through which the operator of the Shaughnessy et al device could monitor the final image.

Therefore, it would have been obvious to combine Shaughnessy et al with Hibino et al to obtain the invention as specified in claim 6.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaughnessy et al in view of Brownstein.

Re claim 6, Shaughnessy et al discloses (column 14, lines 3-7) the display of the scanned image on a display device.

Shaughnessy et al does not describe the display of the scanned image in an enlarged state. The enlargement of a scanned image for display on a monitor is well known in the art as disclosed for example by Brownstein (column 1, line 62 - column 2, line 2). The use of such enlargement of the scanned image of Shaughnessy et al to generate such an enlarged image would be an

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expedient obvious to one of ordinary skill in the art. The motivation for the use of such enlargement would be to provide a more detailed monitor image through which the operator of the Shaughnessy et al device could monitor the final image.

Therefore, it would have been obvious to combine Shaughnessy et al with Brownstein to obtain the invention as specified in claim 6.

***Allowable Subject Matter***

8. Claim 14 is allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

Re claim 14, the art of record does not teach or suggest the recited printing of a document output from an image processing operation, use of a comparison between a scan of the printout result and a scan of the original document in conjunction with the recited arrangement for correction of image data on the basis of an identifying mark.

***Response to Arguments***

10. Applicant's arguments, see Response filed 2/9/06 (page 12, line 1 - page 14, line 15), with respect to the rejection(s) of claim 4 under 35 USC §102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of

rejection of claims 4 (and its dependent claims 5-7 & 12) is made in view of Shaughnessy et al or Ng under 35 USC §103.

11. Applicant's arguments filed 2/9/06 re claim 7 (page 15, lines 1-7) have been fully considered but they are not persuasive.

Applicant argues that Shaughnessy et al and Ng et al "merely describe a comparator to distinguish highlighted areas from unhighlighted areas on a support that is reflective to UV light using a scanned image data... and they do not describe comparing the print image data with the scanned image data".

However, as noted above, the (not further specified) "print image" data is readable upon the comparison threshold used to determine which portions of the "print image" bear the UV instruction marks described by Shaughnessy et al and Ng et al.

#### **Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.

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The examiner can normally be reached on weekdays 7:00-4:30,  
alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

  
Stephen M. Brinich  
Examiner  
Technology Division 2625

smb  
March 16, 2006